

LAW OFFICES  
**ALIX, YALE & RISTAS, LLP**

(FORMERLY CHILTON, ALIX & VAN KIRK)

750 MAIN STREET

HARTFORD, CONNECTICUT 06103-2721

(860) 527-9211

JAMES E. ALIX

GUY D. YALE

L. JAMES RISTAS

RICHARD H. BERNEIKE

CLIFFORD P. KELLY

JAMES E. PIOTROWSKI

THOMAS J. MENARD

BENJAMIN Y. AGREST

OF COUNSEL

RALPH H. CHILTON

ROGER A. VAN KIRK

PATENT, TRADEMARK,

COPYRIGHT AND

COMPUTER LAW

FACSIMILE

(860) 527-5029

E-MAIL

ayrlp@pctlaw.com

**FACSIMILE TRANSMISSION**

April 23, 2002

To: Examiner M. Alvo  
Group Art Unit 1731  
United States Patent and Trademark Office

Re: United States Patent Application No. 08/907,687  
Title: Method of Pretreating Lignocellulose Fiber-Containing  
Material for the Pulp Making Process  
Inventor: Marc J. Sabourin  
Our Ref.: ANDR/346/US

FAX: (703) 872-9311

FROM: L. JAMES RISTAS, ESQ.

MESSAGE: Please find attached the Supplementary Response to Final Action.

NUMBER OF PAGES BEING TRANSMITTED 3 page(s) including cover sheet.

IF YOU DO NOT RECEIVE ALL PAGES OR ARE HAVING TROUBLE,  
PLEASE CONTACT ALIX, YALE & RISTAS, LLP IMMEDIATELY AT 527-9211  
AND ASK FOR DAHLIA STEELE

CONFIRMATION COPY TO FOLLOW: ☐ Yes ☒ No

The information contained in this telecopy message is intended only for the use of the individual or entity named and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this message in error, please immediately notify us by telephone and return the original message to us at the above address via the U.S. Postal Service. Thank you.

FAX RECEIVED  
APR 23 2002  
GROUP 1700  
Official

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

#27/BM  
5-9-02

In re patent application of: Marc SABOURIN

Application No.: 08/907,687

Examiner: M. Alvo

Filing Date: August 8, 1997

Group Art Unit: 1731

For: **Method of Pretreating Lignocellulose Fiber Containing  
Material for the Pulp Making Process**

**Commissioner for Patents  
Washington, DC 20231**

**Official**  
**FAX RECEIVED**  
**APR 23 2002**  
**GROUP 1700**

VIA FACSIMILE - "OFFICIAL"

Sir:

**Supplemental Response to Final Action**

Applicant hereby supplements the Response after final mailed April 11, 2002, by drawing the examiner's attention to the recently decided *In re Glaug*, Fed. Cir., No. 00-1571 (March 15, 2002) according to which the CAFC held that data in a patent specification should have been considered as evidence of non-obviousness because it was offered as illustrative of an advantageous property of the claimed invention.

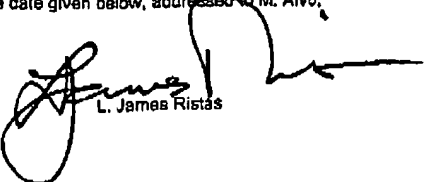
In the subject application, Example 1 of Table A was offered to show that the pretreatment of wood chip material at elevated saturated steam conditions, produces an effect on the chips such that when preheated and refined according to the same reference conditions, the resulting pulp according to the invention is superior (or in the alternative, significant energy savings are achieved when the material is refined to the same pulp quality).

Although the CAFC decision cited above did not specifically address data

**Facsimile Certificate**

I hereby certify that this correspondence is being facsimile transmitted to (703) 872-9311 on the date given below, addressed to M. Alvo, Commissioner for Patents, Washington, DC 20231.

Date: April 23, 2002

  
L. James Ristas

provided in a Rule 132 Declaration, such Declaration is now of record. The Declaration discusses technical papers presented to a sophisticated audience in the relevant field and provides further data supporting applicant's contention that the invention as claimed was not disclosed, taught or suggested by the references of record, nor in any other way a mere obvious increment to the state of the art. Rather, the full scale plant data show a very significant improvement in energy consumption to achieve similar pulp quality.

The technical and patent literature is replete with explanations on the major objective of reducing energy cost in mechanical refining. Many researchers in this field are devoting considerable resources towards this end. Applicant's significant improvement in energy consumption, when viewed against this back drop, provides strong secondary evidence supporting patentability.

As the CAFC noted in the cited decision, "While the measurement of a physical property may not of itself impart patentability to otherwise unpatentable claims, when the measured property serves to point up the distinction from the prior art, or advantages over the prior art, that property is relevant to patentability and its numerical parameters can not only add to precision to the claims but also may be considered, along with all of the evidence, in determination of patentability".

Respectfully submitted,  
Marc SABOURIN



L. James Ristas  
Registration No. 28,663  
Alix, Yale & Ristas LLP  
Attorney for Applicant

Date: April 23, 2002  
750 Main Street  
Hartford, Connecticut 06103-2721  
Tel. No.: (860) 527-9211  
Our Ref: ANDR/346/US

C:\Temp\527-5029\AMENDMENT AND RISTAS\008 P03 - Supplemental - 04-23-02.doc